

REMARKS

Claims 1-111 are currently pending in this application, with claims 1, 43, 64, 80, and 96 being independent.

In the Office Action, claims 1-111¹ were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,937,870 to Gueret ("Gueret") in view of U.S. Patent No. 5,176,156 to Ashtary et al. ("Ashtary").

The rejection of claims 1-111 under 35 U.S.C. § 103(a) should be withdrawn because *prima facie* obviousness has not been established with respect to those claims. To establish *prima facie* obviousness under 35 U.S.C. § 103(a), the Examiner must show first that the prior art references teach or suggest all the claim limitations. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). Second, the Examiner must show that there is some suggestion or motivation, either in the references or in the knowledge generally available to one of ordinary skill in the art, to modify or combine the references in a manner resulting in the claimed invention. *In re Rouffet*, 149 F.3d 1350, 47 USPQ2d 1453 (Fed. Cir. 1998). Third, the Examiner must show that there is a reasonable expectation of success to modify or combine. *In re Dow Chem. Co.*, 837 F.2d 469, 473, 5 USPQ2d 1529, 1531 (Fed. Cir. 1988). Moreover, "[b]oth the suggestion and the reasonable expectation of success must be found in the prior art reference, not in the Applicant's disclosure." *In re Vaeck*, 947 F.2d 488, 493, 20 USPQ2d 1438, 1442 (Fed. Cir. 1991).

¹ Applicant notes that the rejection statement lists all of pending claims 1-111 as being rejected even though the Office Action Summary identifies certain claims as being withdrawn from consideration. In light of that inconsistency, Applicant respectfully requests clarification of the status of each of pending claims 1-111.

In this case, *prima facie* obviousness has not been established with respect to independent claims 1, 43, 64, 80, and 96 at least because (1) neither Gueret nor Ashtary, nor any combination thereof, teaches or suggests all of the features recited in independent claims 1, 43, 64, 80, and 96; and (2) even if the supposed combination could yield all of the claimed features – a notion which Applicant disputes – the Office Action does not set forth a proper motivation to modify or combine Gueret and Ashtary in a manner resulting in Applicant's claimed invention.

The Office Action acknowledges that "Gueret does not disclose the free end of the brush portion not being aligned with the longitudinal axis of the one end portion of the stem." Office Action, page 3, lines 14-15. The Office Action alleges that such a feature is shown in Fig. 2 of Ashtary. Office Action, page 3, line 20--page 4, line 1. The Office Action further alleges that "it would have been obvious to one having an ordinary skill in the art at the time the invention was made to employ the particular brush portion as taught by Ashtary et al into the mascara brush of Gueret for the purpose of enhancing the ability of the device to curl the eyelashes." Office Action, page 4, lines 6-11.

Ashtary is directed to a mascara applicator device including a scissor mechanism for clamping two brushlike elements together. Abstract and Fig. 1. Contrary to the allegation in the Office Action, Fig. 2 of Ashtary does not necessarily disclose or suggest a device including, among other things, a "brush portion having a free end that is not aligned with the longitudinal axis of the one end portion of the stem," as recited in claims 1, 64, 80, and 96, or a method involving "a brush portion free end not aligned with a longitudinal axis of an end portion of a stem to which the brush portion is adapted

to be connected,” as recited in claim 43. The text of Ashtary does not appear to describe any such subject matter. For example, Ashtary lacks any description of the orientation of the free end of the brushlike element 32 relative to a longitudinal axis of sleeve-like member 28. Therefore, it appears that the Examiner relies solely on Ashtary’s Fig. 2 in the claim rejection.

Drawings and pictures can disclose claimed structure if they clearly show the structure which is claimed. *In re Mraz*, 455 F.2d 1069, 173 USPQ 25 (CCPA 1972); see also MPEP 2125. In this case, however, the drawings of Ashtary do not clearly show the above-mentioned features of claims 1, 43, 64, 80, and 96. For example, Fig. 1 is a perspective view, and Fig. 2 appears to be a partial perspective and cross-section view. With such limited views, the drawings do not provide an accurate indication of the orientation of the free end of the brushlike elements 32 with respect to respective longitudinal axes of the sleeve-like members 28. As such, it is unclear whether or not the free ends of the brushlike elements 32 shown in Figs. 1 and 2 are aligned with the respective longitudinal axes of sleeve-like members 28. Therefore, these drawings do not necessarily disclose or suggest a brush portion free end not aligned with a longitudinal axis of an end portion of a stem, as recited in the independent claims.

Because the Office Action does not establish that the applied art discloses or suggests all of the features of independent claims 1, 43, 64, 80, and 96, at least one of the essential criteria for establishing a *prima facie* case of obviousness is lacking. For at least this reason, the § 103(a) rejection of claims 1, 43, 64, 80, and 96, based on Gueret and Ashtary should be withdrawn.

In addition to the fact that the Office Action does not show that the features of claims 1, 43, 64, 80, and 96 can be found in some combination of Gueret and Ashtary, a case for *prima facie* obviousness also has not been established with respect to these claims at least because the requisite motivation to combine the references is lacking. Simply because references can be combined or modified does not render their combination obvious unless the references also suggest the desirability of the modification. *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990). The Examiner can satisfy the burden of establishing a *prima facie* case of obviousness “only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to [modify or] combine the relevant teachings of the references.” *In re Fine*, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988) (citations omitted) (emphasis added). The Federal Circuit has reaffirmed the high burden associated with establishing a *prima facie* case of obviousness and has emphasized the requirement of specificity. *See In re Sang-Su Lee*, 277 F.3d 1338, 61 USPQ2d 1430 (Fed. Cir. 2002).

In this case, the Office Action does not show that a skilled artisan considering Gueret and Ashtary, and not having the benefit of Applicant’s disclosure, would have been motivated to combine or modify the references in a manner resulting in Applicant’s claimed invention. Instead, the Office Action merely identifies certain asserted teachings of the cited references (e.g., Fig. 2 of Ashtary) without supplying a proper motivation for the alleged modification.

The Office Action alleges that a skilled artisan would have modified Gueret in view of Ashtary “for the purpose of enhancing the ability of the device to curl the

eyelashes.” Office Action, page 4, lines 8-9. This allegation appears to be based on a passage in Ashtary including that language. However, the full sentence actually reads: “Also, the brushlike elements can be slightly arched concavely along its longitudinal axis [sic] to further enhance the device’s ability to curl the eyelash (see FIG. 2).” Col. 3, lines 61-64. As is evident from this passage, Ashtary indicates that slightly arcing the brushlike elements enhances the ability to curl eyelashes, not any non-alignment of the brushlike element free end as implied by the Examiner. In fact, as discussed above, the disclosure of Ashtary is silent with regard to the positioning of the free end. Since neither Ashtary nor Gueret provides any motivation or suggestion to modify Gueret to include a non-alignment feature, nothing provides any motivation or suggestion for the modification proposed in the Office Action. Consequently, the conclusions in the Office Action were not reached based on facts gleaned from the cited references and, instead, teachings of the present application were improperly used to reconstruct the references.

For at least the foregoing reasons, the required motivation to combine or modify the applied references is lacking. As such, *prima facie* obviousness has not been established with respect to claims 1, 43, 64, 80, and 96, and the § 103(a) rejection of those claims should be withdrawn.

In order to carry the initial burden of establishing a *prima facie* case of obviousness under 35 U.S.C. § 103(a), the Examiner must also show that there is a reasonable expectation of success. See M.P.E.P. § 2143. The Office Action, however, is completely silent as to any allegation of reasonable expectation of success in combining the alleged teachings of Gueret and Ashtary.

Applicant submits that the alleged combination of Gueret and Ashtary does not show a reasonable expectation of success because, among other reasons, the device of Ashtary functions in a significantly different manner than the device of Gueret. The device of Ashtary includes two brushlike elements that are brought into contact with one another by a scissors mechanism. Abstract. Ashtary discloses that “the brushlike elements are . . . capable of applying mascara and curling the eyelash [sic] when the elements are brought together via the scissors mechanism.” Col. 3, lines 30-34. Nowhere, however, does Ashtary disclose or suggest that the brushlike elements are capable of applying mascara and curling the eyelashes when the elements are NOT brought together. Therefore, there is nothing that would give one of ordinary skill a reasonable expectation that the brushlike elements of Ashtary would be successful at “applying mascara and curling the eyelash[es],” when incorporated into the device of Gueret, which does not require a mechanism for bringing brushlike elements together.

For at least this reason alone, Applicant submits that the Office Action has failed to carry the initial burden of establishing a *prima facie* case of obviousness under 35 U.S.C. § 103(a). Thus, the rejection of claims 1, 43, 64, 80, and 96 under 35 U.S.C. § 103(a) based on Gueret and Ashtary should be withdrawn.

With regard to claims 14-16 and 55, the Office Action acknowledged that neither Gueret nor Ashtary, nor any combination thereof teaches the “shape of the blank surface being [a] frustoconical-shape, fish-like shape, [or] hourglass-like shape.” Office Action, page 4, lines 14-17. The Examiner alleged that such shapes “would have been obvious to one having an ordinary skill in the art at the time the invention was made . . . since such a modification would have involved a mere change in the shape of the

component.” Office Action, page 4, lines 17-21. However, the Office Action provided no motivation to alter the shapes of the devices of Gueret or Ashtary. For at least this reason, the Office Action has failed to carry the initial burden of establishing a *prima facie* case of obviousness under 35 U.S.C. § 103(a). Thus, the rejection of claims 14-16 and 55 under 35 U.S.C. § 103(a) based on Gueret and Ashtary should be withdrawn.

Claims 2-42, 44-63, 65-79, 81-95, and 97-111 each depend from one of independent claims 1, 43, 64, 80, and 96, and should, therefore, be allowable for at least the same reasons those respective independent claims are allowable. In addition, at least some of the dependent claims recite unique features and/or combinations that are not taught by the prior art and, therefore, at least some of the dependent claims also are separately patentable.

In view of the above, Applicant submits that the application is in condition for allowance. Accordingly, Applicant respectfully requests the withdrawal of the rejections under 35 U.S.C. § 103, the reconsideration of this application, and the allowance of pending claims 1-111.

The Office Action contains characterizations and conclusions regarding the related art and Applicant's claims with which Applicant does not necessarily agree. Unless expressly noted otherwise, Applicant declines to subscribe to any such characterizations and conclusions.


Please grant any extensions of time required to enter this Request for
Reconsideration and charge any additional required fees to our Deposit Account No.
06-0916.

Respectfully submitted,

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By: _____


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